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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/710,796
Filing Date: August 03, 2004
Appellant(s): KOCH ET AL.

Brain Kinnear

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12 Mar. 2009 appealing from the Office action mailed 29 Jun. 2007

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner: the 101 rejections for Claims 1-16 and 25.

The remainder of the appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0078973

Przekop et al.

10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Przekop et al (US 200300789973, published Apr 24, 2003).

Regarding independent claim 1, Przekop teaches providing electronic versions of transcripts with links operably connecting the electronic versions of transcripts with electronic versions of exhibits, the method performed on a processor comprising the steps of: importing one or more electronic transcript files and one or more electronic exhibit files to a publisher; establishing an operable electronic link in at least one of the electronic transcript files between the at least one of the electronic transcript files and at least one of the electronic exhibit files; writing the one or more electronic transcript files and the one or more electronic exhibit files with the established operable electronic link to at least one memory file on the computer readable medium; and providing a means on the computer readable medium to view the one or more electronic transcript files and the operably linked one or more electronic exhibit files. For example, Przekop

discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16).

Regarding claim 2, Przekop teaches writing to a portable computer readable medium device. Przekop discloses downloading to a laptop (para 28).

Regarding claim 3, Przekop teaches portable computer readable medium device comprises a magnetic disk, an optical disk, a tape, or a removable hard disk (para 28).

Regarding claim 4, Przekop teaches writing to the computer readable medium that comprises a local memory file accessible from a local processor. For example, Przekop discloses the server automatically writing the files to a compact disk or

desktop/laptop (para 28).

Regarding claim 5, Przekop teaches writing to the computer readable medium that comprises a remote memory file accessible from a local processor. For example, Przekop discloses a connection between a client and server, where the transcripts can be saved to a removable storage medium (para 16).

Regarding claim 6, Przekop teaches wherein the remote memory file is accessible through a network (paragraph 10, bottom “network such as the Internet”).

Regarding claim 7, Przekop teaches wherein the network comprises at least one of a LAN, WAN, WLAN, Wi Fi network, Ethernet, Internet, World Wide Web, or an optical network (paragraph 10, bottom “network such as the Internet”).

Regarding claim 8, Przekop teaches establishing a network connection between the at least one memory file and a local processor; and launching a viewer the provided means to view at the local processor. Przekop discloses clients with web browsers for viewing the transcript and synchronize video/audio (para 13), distributed by the server on a connection between client and server (para 16).

Regarding claim 9, Przekop teaches the step of establishing the operable electronic link comprises establishing a hyper-link from the at least one of the one or

more electronic transcripts to at least one of the one or more electronic exhibits.

Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom).

Regarding claim 10, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at a first reference to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

Regarding claim 11, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at all references to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom). The examiner characterizes this limitation as a hyperlink established to reference an electronic exhibit.

Regarding claim 12, Przekop teaches the hyper-link is established in the at least one of the one or more electronic transcripts at one or more user defined link points to the at least one of the one or more electronic exhibits. Przekop discloses a link in the transcript and when the member clicks on the line number, the software opens the browser window and launches the video services and presents the desired portions of the video/audio in its own frame (para 36, bottom), where the links are embedded in the transcript (para 11; para 24), embedded by a server.

Regarding claim 13, Przekop teaches a means to view step provides a means to view the electronic transcript and the operable electronic linked electronic exhibit substantially simultaneously. Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 “user wants to see text as well as video”).

Regarding claim 14, Przekop teaches providing a means to view step further provides independent controls of the viewed electronic transcript and the operable electronic linked electronic exhibit. Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 “user wants to see text as well as video”). The examiner interprets each frame (401 and 402) as being independent because the user can search the text frame without any action on the video frame.

Regarding claim 15, Przekop teaches providing an interface to allow a user to select one or more electronic transcripts to view. For example, Przekop discloses allowing a user to read each transcript (para 30 and 31). If a user is granted access, someone must have selected which transcript the designated user is allowed to view.

Regarding claim 16, Przekop teaches means to view electronic exhibit files selected from a group of files consisting of: video, audio, video/audio, animation, MPEGs, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGs (para 16).

Regarding claim 17, Przekop teaches an electronic transcript and at least one associated electronic exhibit, the computer readable medium comprising: an importing module configured to import one or more electronic transcript files and one or more electronic exhibit files; an association module configured to establish an operable electronic link in the one or more electronic transcript files to provide an operable electronic link between at least one of the one or more electronic transcript files and the one or more electronic exhibit files; a writing module configured to write the imported electronic transcript files and electronic exhibit files with the operable electronic link established by the association module to at least one memory file in the computer readable medium; and a viewing module in the computer readable medium configured to allow a user to view the at least one memory file. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of

legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record (Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16). Additionally, the video can be imported to conventional litigation support software (para 28). The transcript file is converted to a .PDF and stored on a server along with the associated video/audio records (para 33), which the examiner equates to the claimed limitation of importing because storing a transcript on the server implies that the transcript was imported or copied onto the server and the conversion to PDF is the same as importing to a PDF. The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36), which is equivalent to the claimed viewing module.

Regarding claim 18, Przekop teaches a writing module is configured to write a file accessible to the computer readable medium over a network. For example, Przekop discloses saving records and transcripts to a storage medium across a connection

between client and server (para 16).

Regarding claim 19, Przekop teaches the writing module is configured to write the at least one memory file to a computer readable medium selected from a group of medium consisting of: a magnetic disk, and optical disk, a tape, a removable hard disk, a CDROM, or a DVD disk (para 28). For example, Przekop discloses saving records and transcripts to a storage medium, across a connection between client and server, such as a compact disk (para 16).

Regarding claim 21, Przekop teaches a viewing module is configured to view at least one of video, audio, video/audio, animation, MPEGS, still images, text files, TIF, PDF, JPG, bitmap, GIF format, and JPEGS (para 16).

Regarding claim 22, Przekop teaches the viewing module is configured to access the at least one memory file on the computer readable medium through a network connection (paragraph 10, bottom “network such as the Internet”).

Regarding claim 23, Przekop teaches viewing module is configured to download the at least one memory file from the computer readable medium. Przekop discloses downloading the transcript and the video/audio record as a MPEG-1 file (para 36).

Regarding claim 24, Przekop teaches viewing module is configured to stream the at least one memory file from the computer readable medium. Przekop discloses transmitting the video/audio record as a scalable video stream (para 36).

Regarding claim 25, Przekop teaches a viewable electronic transcript and an associated electronic exhibit, the apparatus comprising: at least one memory file in a computer readable medium; and at least one processor, wherein the at least one memory file in the computer readable medium comprises: one or more electronic transcript files; one or more electronic exhibit files; and at least one operable link in the one or more electronic transcript files operably linking at least one of the one or more electronic transcript files and at least one electronic exhibit file of the one or more electronic exhibit files; the at least one processor comprises: a reader to read the at least one memory file from the computer readable medium; and a viewer to display the at least one memory file displayed, the viewer being configured to allow simultaneous display of the one or more electronic transcript and any operable electronically link electronic exhibits. For example, Przekop discloses a web-enabled method for distribution of transcript-synchronized video/audio recorder of legal proceedings to collaborative workgroups, where the server provides storage for video/audio records and corresponding transcripts (Abstract section). The server-side software synchronizes transcript and video/audio record so that each transcript line is synchronized to corresponding portion of the video/audio record, each transcript line containing a selectable link to the corresponding portion of the video/audio record

(Abstract section; paragraph 11), providing the benefit of allowing a quicker comparison of a deponent's demeanor with the transcript (para 7). The examiner characterizes the claimed *exhibit file* to include video/audio files accessible by a viewer (see specification, paragraph 21), and equivalent to the video/audio files disclosed by Przekop (para 16). The user's can view the transcript and the associated video/audio in a browser (as shown in Fig 4; para 36). Przekop discloses a multi-frame web browser with video image presented in a first frame 401 and the transcript presented in a second frame 402 (para 36; fig 4, items 401 and 402; para 42 "user wants to see text as well as video "), which the examiner equates to the claimed "simultaneous display" because frames 401 and 402 are displayed at the same time.

(10) Response to Argument

A. Claims 1-16 and 25 are patentable under 35 U.S.C. § 101.

As previously indicated, the Examiner withdraws all previous 35 U.S.C. § 101 rejections.

B. Claims 1-19 and 21-25 are patentable under 35 U.S.C. § 102(a) over United States Patent Application Publication No. 2003/0078973 to Przekop et al.

Firstly, the examiner notes that **nowhere** in the Appeal Brief does Appellant expressly state which claim limitation Przekop fails to disclose. Thus, Appellant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited. Accordingly, Appellant fails to persuasively argue that any of the claims are patentably distinguishable over Przekop.

Secondly, Appellant argues that Przekop fails to disclose the limitations in Claims 1, 17 and 25 because a "transcript" and an "exhibit" are documents containing different information. See *Brief* – Page 6, fourth paragraph.

The examiner disagrees.

In response to Appellant's argument that the references fail to show certain features of appellant's invention, it is noted that the feature upon which applicant relies

(i.e., a "transcript" and an "exhibit" being documents **containing different information**) is **not** recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, the "electronic transcripts" and "electronic exhibit files" disclosed in Przekop are "different" in that the "electronic transcripts" are textual versions of corresponding legal proceedings and the "electronic exhibit files" are video/audio recordings of the corresponding legal proceedings. As expressly noted in Przekop (see Page 5, Paragraph 0047), watching the audio/video recording that corresponds with the desired portion of the "textual" deposition allows the user to immediately and easily analyze the demeanor of the witness. In this way, the "electronic transcripts" and "electronic exhibit files" disclosed in Przekop are files containing different information. Additionally, the examiner notes that a video/audio recording of a proceeding could reasonably be used as an "exhibit" to prove the veracity of a textual transcript of the proceeding, as expressly disclosed in Przekop (see Page 1, Paragraph 0005).

Finally, **before** the time the present invention was made, depositions took place, and, during at least one of those depositions, a first party presented a physical item (e.g., an "exhibit") to a second party. Accordingly, by disclosing an electronic "textual" transcript of a deposition and a corresponding audio/video recording of the deposition, Przekop disclosed "operably connecting the electronic versions of transcripts with electronic versions of exhibits," as recited in Claim 1.

Art Unit: 2176

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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